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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,109	09/28/2001	Trevor Vernon Smith	3120.00026	8086

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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/17/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/967,109

Applicant(s)

SMITH, TREVOR VERNON

Examiner

Nini F. Legesse

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 12-24, 27 and 28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 12-24, 27 and 28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

Art Unit: 3711

### **DETAILED ACTION**

**Applicant's cancellation of claims 10 and 11, and amendments to claims 1, 8, and 21 is acknowledged in paper no. 10.**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "position retaining means" as stated in claim 9; and the "resilient member" as stated in claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 6-9, 12-15, 19, 20, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Burgess (US Patent No. 476,246).**

Art Unit: 3711

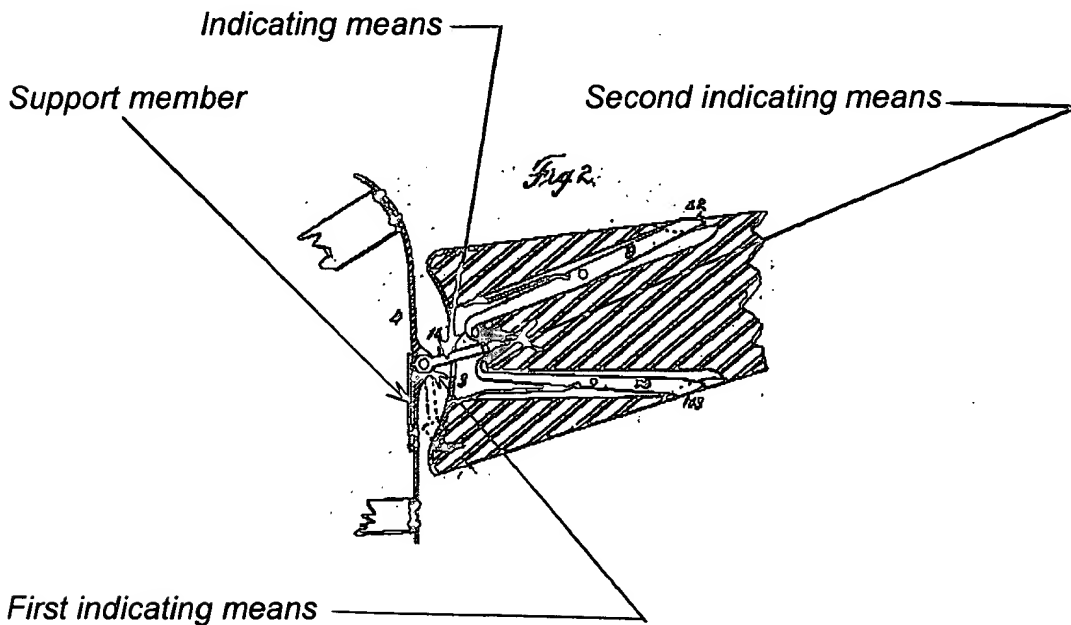
Burgess discloses a golf swing indicator (10) comprising:

- An attachment means (the device as shown on Figs. 1-2) for attaching a support member (4) adjacent to a single shoulder of a golfer, the support member (4) having shoulder position indicator means projecting outwardly and forwardly from the user (11);
- The shoulder position indicator means (11) is adjustably secured to the support member (since column 1, lines 52+ indicates that projection 11 is pivots, it is considered to be adjustable);
- Position retaining means (item 4 is considered as a position retaining means because once projection 11 pivots downwardly it will be limited to certain position by the shoulder plate 4 as shown on Fig. 2)
- The shoulder position indicator means (11) comprises a first indicator member (the pivot point of item 11 as shown on Fig. 2) that is supported by the indicator arm (11) and a second indicator member (the opposite end of item 11 that is away from the pivot location as shown on Fig. 2);
- The support member (4) is located over the forward shoulder of the golfer relative to the swing (Figs. 1-2); and
- Said shoulder position indicator means can be moved in at least two planes, wherein said at least two planes are perpendicular to each other (since Applicant has not indicated that the device has to be in any specific orientation or location, it is concluded that Burgess' device when picked up by a hand and swung up and down or side to side, it is also capable of being moved in at least two planes).

Art Unit: 3711

With respect to the intended use recitations of the claims, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

*For clarifying Examiner's broad interpretation of the claims of the instant application, Fig. 2 of the above reference, US Patent No. 476,246, is provided below.*



### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 3711

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5 and 22-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess.

Burgess discloses the invention as recited above but fails to show the indicator arm to comprise a resilient member. Burgess has indicated that projection (11) is adapted to project through a buttonhole opening (column 2, lines 56-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a resilient member like a rubber at the tip end of projection 11 for safety purposes.

With respect to claims 22-24, they appear to be directed to the obvious method of using the Burgess device.

**Claims 16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgess in view of Coontz (US Patent No. 4,976,388).

Burgess fails to teach the use of a flexible pad and the use of shoulder pad.

Coontz teaches the use of a flexible shoulder pad (15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide shoulder pads as taught by Coontz in the Burgess device in order to provide comfort for the wearer of the device.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 12-24, 27, and 28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

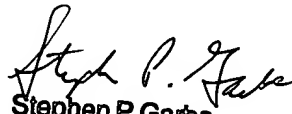
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Garbe can be reached on (703) 308-1207. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL  
09/10/04

  
Stephen P. Garbe  
Primary Examiner